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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1944.

No. **1084**

KRAFT CHEESE COMPANY,

*Petitioner,*

*against*

CONWAY P. COE, COMMISSIONER OF PATENTS,

*Respondent.*

**PETITION AND BRIEF FOR WRIT OF CERTIORARI.**

TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT  
OF COLUMBIA.

CYRIL A. SOANS,

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Chicago 3, Illinois.



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*Petitioner,*

*vs.*

CONWAY P. COE, COMMISSIONER OF PATENTS,

*Respondent.*

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**PETITION FOR A WRIT OF CERTIORARI.**

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TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT  
OF COLUMBIA.

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*To the Honorable the Chief Justice and the Associate  
Justices of the Supreme Court of the United States:*

Petitioner, Kraft Cheese Company, respectfully petitions this Court to issue a writ of certiorari to review a judgment of the United States Circuit Court of Appeals for the District of Columbia finally entered on January 4, 1945.

## STATEMENT OF THE MATTER INVOLVED.

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On June 6, 1940, the Petitioner, Kraft Cheese Company, filed its application Serial No. 432,724 in the United States Patent Office, under the Act of 1905,<sup>1</sup> for registration of of the mark "OLD ENGLISH" (written in "Old English" type), which trade-mark Petitioner and its predecessors have been using upon cheese since about the year 1912. The application was rejected by the Examiner, which rejection was affirmed by the Commissioner of Patents, and, thereafter Petitioner filed suit in the District Court of the District of Columbia in order to overcome the Commissioner's refusal to register the mark.

The District Court denied relief, and the Petitioner appealed to the United States Court of Appeals for the District of Columbia, which affirmed the District Court, holding that (a) the word "English" was geographical and (b) the word "old" was descriptive, and that the mark was on that account unregistrable, citing a part of Section 5 of the 1905 Act (15 U. S. C. 85), which part provides:

"That no mark which consists \* \* \* merely in words or devices which are descriptive of the goods with which they are used \* \* \* or merely a geographical name or term, shall be registered under the terms of this [Act]. \* \* \*"

The full text of the relevant part of Section 5 of the act is printed on the fly-leaf at the end of this brief.

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1. Act of February 20, 1905, Statutes at Large, Chapter 592, Sections 10-30 inclusive, 33 Statute, pages 724 to 731 inclusive (U. S. C. Title 15, Sections 81-108 inclusive).

## JURISDICTION.

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The suit in the District Court was brought under the provisions of Section 9 of the Trade-Mark Act, February 20, 1905 (15 U. S. C. 89) and Sec. 4915 of the Revised Statutes (15 U. S. C. 35) as interpreted by the Supreme Court of the United States in the case of *Baldwin Company v. Robertson, Commissioner of Patents, et al.*, 265 U. S. 168.

From the decision of the District Court, appeal was taken under Sec. 128 of the Judicial Code (U. S. C. Title 28, Sec. 225). The Court of Appeals, D. C., affirmed the decision of the District Court on December 18, 1944. A petition for rehearing was filed on January 2, 1945, and denied on January 4, 1945.

## THE QUESTION PRESENTED.

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In this case, Petitioner has shown by uncontradicted evidence that the mark **in its entirety** (a) serves to distinguish its goods from the goods of others; (b) does not describe any properties or characteristics of the goods; (c) has no geographical meaning.

The mark thus satisfies the requirements of the general language of Section 5, the first part of which reads as follows:

“That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark, unless such mark,” etc.

The **question** is whether the Commissioner of Patents may refuse to register a composite two-word trade-mark, which, **in its entirety** is fanciful and legitimate at common law, merely because each word would be separately unregistrable?

### REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.

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1. The question involved is of general importance, since it involves the registrability of large numbers of valuable composite fanciful marks, the elements of which are separately unregistrable.

2. The above question is of substance, it involves an interpretation of Sec. 5 of the 1905 Act, and has not been, but should be settled by this court.

3. The Court of Appeals, by improperly enlarging the scope of the provisos in Sec. 5 of the 1905 Act, has not given proper effect to the rule laid down by this Court in *U. S. v. Dickson* (40 U. S.), 15 Peters 141, 165, which directed that provisos of this character should be strictly construed; and has not given proper effect to the directions of this Court in the case of *Beckwith v. Commissioner of Patents*, 252 U. S. 538, expressed in the following language:

(Page 544)

“It must be noted that the requirement of the statute that no trade-mark shall be refused registration except in designated cases is just as imperative as the prohibition of the proviso against registration in cases specified.”

(Page 545)

“refusal to register a mark \* \* \* deprives him of the benefits of the statute, and this should not be done, if



it can be avoided by fair, even liberal construction, of the Act, designed as it is to promote the domestic and foreign trade of our country."

(Page 545)

"The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered **in its entirety \* \* \***"

4. In deciding that the phrase "OLD ENGLISH" is unregistrable, on the theory that it is not a good technical trade-mark for cheese, the Court of Appeals has not given proper effect to the decisions of this Court in *American Foundries v. Robertson*, 269 U. S. 372, 381, which held that the purpose of the 1905 Act was to permit registration of all "**legitimate**" **common law trade-marks**, and in *Hamilton Brown Shoe Company v. The Wolf Bros. & Company*, 240 U. S. 251, 256, wherein it was held that the mark "THE AMERICAN GIRL", for ladies' shoes, was not descriptive and was not geographical, but was fanciful, and therefore a legitimate trade-mark.

## BRIEF IN SUPPORT OF PETITION.

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### THE FACTS.

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The depositions, testimony and exhibits received in evidence in the case established, without contradiction by the Commissioner, the following facts:

1. The mark "Old English" has been used by Petitioner and its predecessors as a trade-mark for cheese since the year 1912 (App. 31).

2. The mark "Old English" has been written in a kind of type known as "Old English" (See App. 44) as shown in the trade-mark drawing (App. 43) and in the various wrappers and packages (Plaintiff's Exhibits 1 to 11, incl.) continuously since at least as early as the year 1920. No other style or type or lettering has been used since that date (App. 24).

3. The cheese sold under this brand by Petitioner is Kraft Cheese Company's "top brand" of cheese (App. 7 and 13). This brand of cheese is not now available for general sale because of Army and Navy and Lend-Lease requirements, which make it impossible for Petitioner to obtain high-grade well-cured cheese for the purpose of manufacturing cheese worthy of being sold under the "Old English" label (App. 10-11).

4. Before the present emergency developed, Petitioner was manufacturing and selling this high-grade cheese under the "Old English" label in large quantities throughout the United States. During the eight years prior to 1942, the sales exceeded five million (5,000,000) pounds annually (App. 33).

5. "Old English" brand cheese sells for a considerably higher price than any other cheese of similar type put out by Petitioner (App. 21).

6. The words "process cheddar cheese" used on Petitioner's labels and packages indicate the particular type and style of cheese put out by Petitioner under said labels. The word "cheddar" means cheese made by the cheddar process, the process used in making so-called American cheese (See Plaintiff's Exhibit 16, App. 45). The word "process" means cheese which is no longer in its original form, but which has been "processed" by grinding it and pasteurizing it at a temperature which will permit it to be poured into any desired shape or size of package (App. 7). See also Government Bulletin, Plaintiff's Exhibit 16, (App. 46) Section 19 of which defines "process cheese." Under U. S. Government regulations, Petitioner's "Old English" cheese, which contains an emulsifier, cannot be called pasteurized cheese, but must be labeled "process cheese" (App. 7 to 8). See also the Bulletin, Sections 18 and 19 (App. 46). See also Snyder's testimony (App. 27 to 28).

7. There is no type of cheese known under the varietal name "English" or "Old English." See Government Bulletin, pages 5 and 6, Plaintiff's Exhibit 16 (App. 45 and 46). See also Riggs' testimony (App. 9 and 10), Snyder's testimony (App. 31), Mulligan's testimony (App. 20). There is no cheese-making process known as the "English Process." (Rigg's testimony, App. 14.) See also John Kraft's testimony (App. 31).

8. The word "old" is not used in selling cheddar or American type cheese to indicate quality, or that the cheese has become well-cured or aged, or has developed a sharp, snappy flavor. On the contrary, the word "old", if used in connection with such cheese, is a derogatory term. Customers never ask for "old cheese" (Mulligan Testimony, App. 21; Riggs Testimony, App. 11 and 12).

9. Since the inception of the use of the brand "Old English" by Petitioner and its predecessors, all of the cheese sold under that name has been manufactured in the United States (App. 10 and 36). No complaint has ever been made by any governmental authority as to false marking or advertising in respect to the place of origin or manufacture, because of the use of the mark "Old English" (App. 25 to 26).

10. Except for Petitioner's cheese, there has never been on the market, in this country, any other cheese known as "Old English" or sold under the brand "Old English," except in the case of a brief minor local infringement in Chicago, Illinois, during the year 1925, which was promptly discontinued after complaint was made (App. 26).

11. The mark "Old English" is used by Petitioner to distinguish its cheese from cheese made by others, and for no other purpose (Riggs App. 13, Mulligan App. p. 21).

12. Petitioner has disclaimed exclusive use of the word "English" apart from the mark "Old English" (App. p. 41).

## ARGUMENT.

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### Proposition No. 1.

The intent of the Trade-Mark Act of 1905 was to afford the fullest possible protection of the property rights of the owner of a common law trade-mark used in Federal commerce.

Although Congress did not define a trade-mark in the Act of 1905, it is recognized that a trade-mark is any word, symbol or other marking which functions "to identify the origin or ownership of the article to which it is affixed." *The "Tea Rose" Case, Hanover Milling Co. v. Metcalf*, 240 U. S. 403, 412.

The plain intent of Congress was not to deny registration of any mark unless the use of it as a trade-mark would not be sanctioned at common law. See *American Foundries v. Robertson*, 269 U. S. 372, 381, where this Court said:

"\* \* \* it reasonably may be assumed, also, that, to the extent the contrary does not appear from the statute, the intention was to allow the registration of such marks as that law, [the substantive law of trade-marks] and the general law of unfair competition of which it is a part, recognized as **legitimate**. The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question, said: 'Section 5 of the proposed bill we believe will permit the registration of all marks which could, under the common law as expounded by the Courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark.' Report No. 3147, Dec. 19, 1904, H. of R., 58th Cong., 3d. Sess."

The 1905 Act should be construed liberally so as to benefit owners of trade-marks by allowing them to register their marks in the United States Patent Office thereby to promote our domestic and foreign trade. See *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 545:

“Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, **and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed as it is to promote the domestic and foreign trade of our country.**” (Emphasis added.)

Sec. 1 of the 1905 Act (15 U. S. C. 81) says “That the owner of a trade-mark \* \* \* may obtain registration for such trade-mark by complying with the following requirements:” (Here follows a list of the formal requirements.)

An examination of Sec. 5 of the 1905 Act (15 U. S. C. 85) in view of Sec. 1, clearly shows that it was the intention of Congress to permit registration of all trade-marks subject only to certain specific exceptions. These exceptions are types of marks (1) the use of which would be against **public policy** for various reasons, or (2) which members of the public have the natural right to use on the goods, *i. e.*, which in a sense are in the **public domain**.

As examples of the first type referred to, the Act excludes those marks which are immoral or scandalous, or which simulate the flags or insignia of nations or public institutions. As examples of the second type of mark, Congress excludes those marks which are descriptive of the goods or which may be used to indicate the place where the goods were made.

The exceptions listed by Congress are marks which inherently are not good “legitimate” or technical trade-marks at common law.

Hence, it would seem that, in administering the Act, the

Commissioner should give due regard to the purposes of the Act and should permit registration of a fanciful mark **unless it clearly appears** (1) the use of the mark is against public policy or (2) is in the public domain. There is no evidence here that the mark is in either category.

### Proposition No. 2.

**Exceptions and provisos of a statutory grant expressed in general terms, require the strictest interpretation, and all doubts should be resolved in favor of the one who qualifies under such general grant.**

Sec. 5 of the Act says:

“that no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark \* \* \* provided that no mark which consists \* \* \* merely in words or devices which are **descriptive of the goods** with which they are used or of **the character or quality** of such goods or merely a **geographical name or term** \* \* \* shall be registered under the terms of this Act.”  
(Emphasis added.)

It is seen that these exceptions are set up in a proviso which follows a general enactment to the effect that **“no mark \* \* \* shall be refused registration as a trade mark on account of the nature of such mark.”** The law is clear that under these circumstances, *i. e.*, where a proviso seeks to except something from the general language of a remedial statute, the proviso should be strictly construed and that the exceptions must be clearly established. See *U. S. v. Dickson* (40 U. S.), 15 Peters 141, 165 (Story, J.):

“\* \* \* we are led to the general rule of law which has always prevailed, and become consecrated almost as a maxim in the interpretation of statutes, that where the enacting clause is general in its language and ob-

jects and a proviso is afterwards introduced, that proviso is construed strictly, and takes no case out of the enacting clause which does not fall fairly within its terms. In short, a proviso carves special exceptions only out of the enacting clause; and *those who set up any such exception, must establish it as being within the words as well as within the reason thereof.*" (Emphasis added.)

Applying these familiar principles, it would seem that unless the mark of applicant, **as an entirety**, is shown by convincing evidence to be descriptive or geographical, it is the duty of the Patent Office to register it.

### Proposition No. 3.

**The composite mark "Old English" is neither descriptive nor geographical. It is Not in the Public Domain.**

Dr. Riggs was asked the question (App. 13):

"Q. Does it (the trade-mark 'Old English') indicate that it is made by some English process?"

This question was finally answered on page 14, when the witness said:

"A. No, because I do not know of any process known as an English process."

The witness, Mulligan (App. 19) was asked the question:

"Q. Does it (the mark 'Old English') convey to you the idea that it is made by some old English process or English process?"

"A. No, sir, I wouldn't say that it does.

"Q. Well, does it convey to you the idea that it is made by the Kraft Cheese Company?"

"A. Mainly, that's the thing; it is a Kraft product.

"By the Court:

"Does it convey to you the idea that it is similar to cheese that formerly was made in England?"

"A. No, sir. It is strictly a trade label to me."



Mr. Snyder (App. 28) testified as follows:

"Q. Now, is there any variety of cheese known as 'English' cheese?

"A. There is not any such variety to my knowledge, and I am sure I would be acquainted with it if there was."

Furthermore, the Government Bulletin (App. 45 and 46) which lists the sixteen principal varieties of cheese known in this country, contains no reference to any cheese known as "English cheese" or to any process known as an "English process."

Hence it is shown that the mark "Old English" does not describe the cheese or the process by which the cheese is made, nor does the mark indicate that the cheese is made in England or in any other locality. Hence, the mark as a whole is not descriptive, nor is it geographical; it is not in the public domain.

#### **Proposition No. 4.**

The phrase "Old English" has a recognized dictionary meaning, which is not applicable to cheese, and therefore is purely fanciful.

By reference to page 815 of the Funk & Wagnalls' New Standard Dictionary of the English language, 1929 Edition, Plaintiff's Exhibit 15 (App. 44) it is seen that the words "Old English" are referred to three times as follows:

"In this sense, there are four periods of the history of the English language:

"(a) The period from the earliest Teutonic speech in England, A. D. 450 to A. D. 1150, the Anglo-Saxon period, lately often called Old English.

. . . . .

"(c) the period from 1350 to 1485, the Chaucer

period, the Old English of literature, now often called middle English.

“A type-face resembling German text: more commonly called Old English.”

Thus it appears that, according to the Dictionary, the term “Old English” is used to identify particular periods of early or medieval history of England, and that the term is also used to describe a style of type. The statute, however, does not prohibit the registration of words of historical significance, nor does it prohibit registration of words having only a typographical significance. The Petitioner’s mark is used on cheese, not on history books or on type. As used on cheese the mark is wholly fanciful.

#### **Proposition No. 5.**

**Under the authorities, “Old English” is a legitimate common law trade-mark for cheese.**

#### **“THE AMERICAN GIRL.”**

In the case of *Hamilton Brown Shoe Company v. Wolf Bros. & Company*, 240 U. S. 251, the 1905 Act was not specifically involved, but this Court did definitely hold that the trade-mark “THE AMERICAN GIRL” was fanciful, was not descriptive, was not geographical and was inherently a good trade-mark.

It was contended that plaintiff’s recovery was limited because the phrase “THE AMERICAN GIRL” was not inherently a good technical trade-mark. The Supreme Court rejected this contention and specifically ruled that the phrase “THE AMERICAN GIRL” was a good technical common law trade-mark. See page 256:

“We do not regard the words ‘THE AMERICAN GIRL’ adopted and employed by complainant in connection with the shoes of its manufacture as being a geographical or descriptive term. It does not signify that the

shoes are manufactured in America, or intended to be sold or used in America, nor does it indicate the quality or characteristics of the shoes. Indeed, it does not, in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture."

In the case at bar, as in "THE AMERICAN GIRL" case, the phrase "OLD ENGLISH" is inherently a good technical trade-mark for exactly the same reasons which were assigned by the Supreme Court in the case of "THE AMERICAN GIRL" trade-mark.

### "OLD SOUTH."

In *Southeastern Brewing Co. v. Blackwell*, 80 Fed. (2d) 607, 609 (C. C. A. 4) the trade-mark "OLD SOUTH" for beer was held to qualify as a good technical trade-mark, the Court saying:

"As to the first question, the judge below reached the conclusion that the words 'Old South' or 'Old South Brew', taken together do not constitute a term that is geographical or descriptive in its meaning, but rather indicate a regime or period in history, and that therefore the term is capable of appropriation as a trade-mark. In this conclusion we agree." (Emphasis added.)

In reaching that decision, the Court was not influenced by any suggestion of secondary significance developed by long continued use. On the contrary, the use of the mark by the registrant was so recent and so involved in controversy, that one of the judges dissented on the ground that the evidence failed to show first use of the mark.

It is interesting to note that, following the "OLD SOUTH" decision, the Patent Office has issued registrations of the trade-mark "OLD SOUTH", see Plaintiff's Exhibits 17 and 18 (App. 47, 48).

### **"OLD GERMAN."**

In *Gerhard Lang Brewery v. Phoenix Brewery Corporation*, ..... N. Y. ...., 29 T. M. Rep. 439, 444, the Supreme Court of New York, on April 6, 1939, held that the phrase "OLD GERMAN" was not descriptive or geographical:

"I find that the words 'Old German' are not 'geographical' or 'descriptive' in the sense that they preclude appropriation as a trade-name."

On page 445, the Court said:

"\* \* \* that there is nothing descriptive or generic in the words 'Old German'. \* \* \* Those words do not suggest the location of the Lang Brewery in this country or in Germany, nor that the plaintiff's beer resembles that made in any part of Germany; nor do they indicate that 'Lang's Old German' beer is made according to any specific formula or that it has any particular characteristic or quality."

### **Proposition No. 6.**

**The Court of Appeals has failed to draw a proper line of distinction between composite words which are registrable, and those which are disqualified for registration.**

In this case, the Court of Appeals has dissected the mark into two parts and has then rejected each piece separately. In doing so, the Court has given no consideration to the fanciful meaning of the mark *in its entirety*.

Such piecemeal rejection of a fanciful mark violates the rule laid down by this Court in *Beckwith v. Commissioner of Patents*, 252 U. S. 538, which said (page 545):

"The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered *in its entirety*."

The distinction between composite marks which are registrable and those which are not registrable is derived from the meaning of the mark **in its entirety**. We submit that, in order to determine whether such a mark may be registered, the question should be, "Does the coupling of the two separately unregistrable marks produce a combination or composite mark which **in its entirety** has a fanciful meaning, distinct from the meaning which can be derived from the use of either or both of the separate components?"

For example, take the words "**WISCONSIN CHEDDAR**." Everyone knows that cheese is made in Wisconsin, and that cheddar cheese is a common type of cheese. In the hypothetical mark, "**WISCONSIN CHEDDAR**," the word "**WISCONSIN**" means exactly what it would mean if used in the absence of the word "**CHEDDAR**", and similarly the word "**CHEDDAR**" means a type of cheese, whether it be coupled with the word "**WISCONSIN**" or used separately.

The phrase "**WISCONSIN CHEDDAR**" means cheddar cheese made in Wisconsin, and it is incapable of meaning anything else. It has, and could have, no fanciful meaning and it could not serve to distinguish the cheese of the user from the cheese of others. Thus, it fails to satisfy the initial requirements of Sec. 5, which directs the registration of marks "by which the goods of the owner of the mark may be distinguished from other goods of the same class." Thus it will be seen that the phrase "**WISCONSIN CHEDDAR**" is unregistrable, not because one of its components is geographical and the other is descriptive, but only because the phrase, **in its entirety**, is in the public domain so far as cheese is concerned. It is not a legitimate common law trade-mark for cheese.

On the other hand, the composite mark "**OLD ENGLISH**" does satisfy the requirements of the initial part of Sec. 5

in that **as an entirety**, it has a fanciful meaning not possessed by the separate components, and because it does "serve to distinguish the goods of the owner of the mark . . . from other goods of the same class." In the case of "OLD ENGLISH" the coupling together of the two separately unregistrable words has produced a new fanciful meaning, so that the mark, **in its entirety**, is a legitimate common law trade-mark, it is not geographical or descriptive and is therefore registrable.

### CONCLUSION.

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*To summarize, we submit:*

(1) That the evidence shows that the composite mark "Old English" serves to distinguish Petitioner's cheese from that of other manufacturers, and therefore is a good technical common law trade-mark. Whatever descriptive or geographical significance may have been possessed by the separate word "old", or by the separate word "English," as applied to cheese, was destroyed when the separate words were united to form a new and fanciful combination.

(2) That the composite mark qualifies for registration under the general language of section 5, of the 1905 Act, and it is not disqualified by any of the provisos or exceptions contained in said section.

(3) That, in holding that the mark is not registrable under the Act of 1905, the Court of Appeals has misconstrued said Act and the prior decisions of this Court.

(4) That the writ should be granted and the cause reviewed.

Respectfully submitted,

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March 17, 1945.



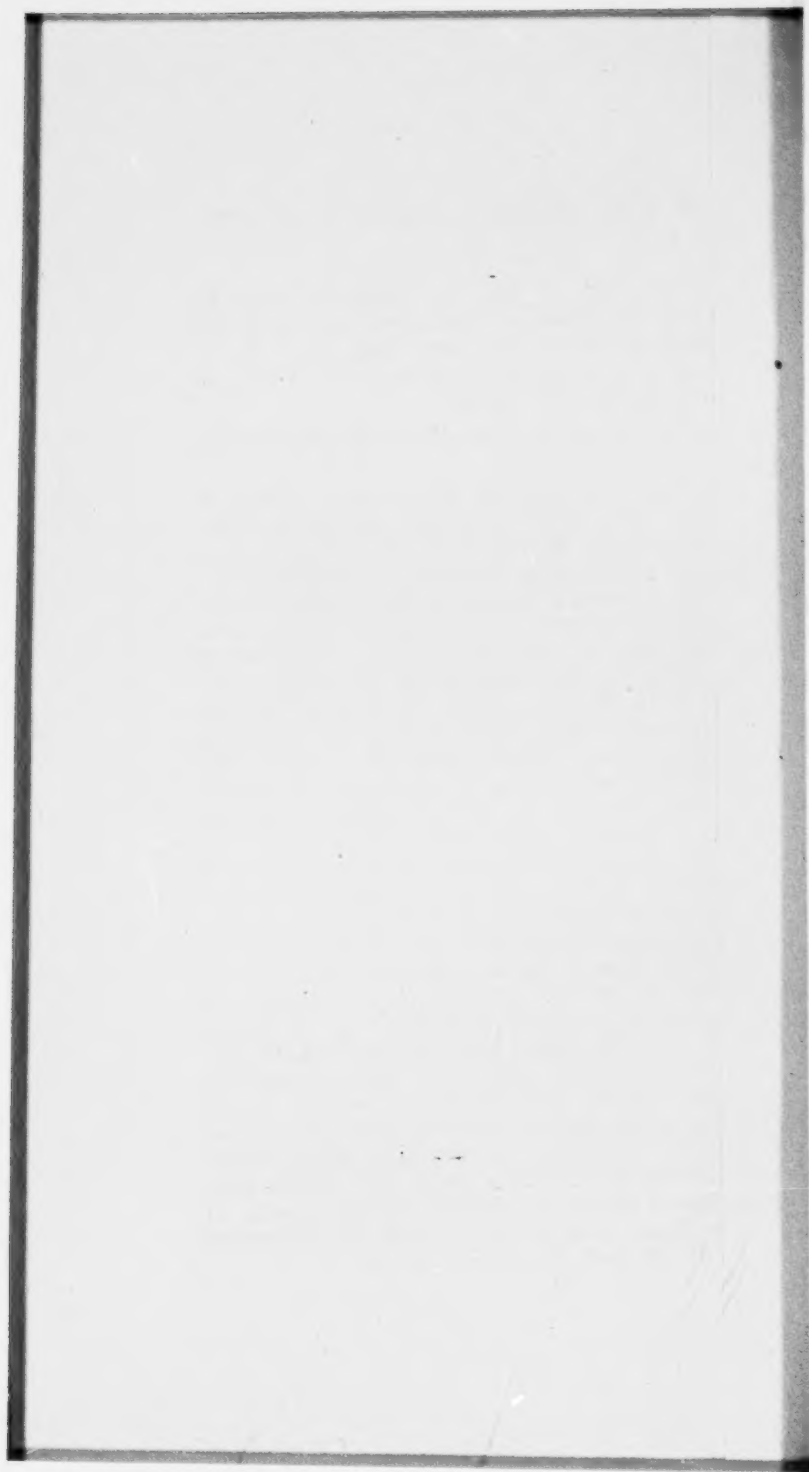


## SECTION 5 OF THE TRADE-MARK ACT OF 1905.

"SEC. 5. U. S. C., title 15, sec. 85. **That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration, as a trade-mark on account of the nature of such mark unless such mark—**

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: **Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: Provided, That no mark which consists** merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or **merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: Provided further, \* \* \***





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# In the Supreme Court of the United States

OCTOBER TERM, 1944

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No. 1084

KRAFT CHEESE COMPANY, PETITIONER

*v.*

CONWAY P. COE, COMMISSIONER OF PATENTS

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*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA*

---

**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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## **OPINIONS BELOW**

The opinion of the District Court of the United States for the District of Columbia (R. 36-37) is reported in 55 F. Supp. 24. The opinion of the Court of Appeals for the District of Columbia (R. 52-53) is reported in 146 F. 2d 313.

## **JURISDICTION**

The judgment of the Court of Appeals was entered on December 18, 1944 (R. 54), and a petition for rehearing was denied on January 4, 1945 (R. 55). The petition for a writ of certiorari was filed on March 27, 1945. The jurisdiction of this Court is invoked under Sec-

tion 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTION PRESENTED

Whether the mark, "Old English," as applied to a cheddar type cheese, is entitled to registration under the Trade-Mark Act of February 20, 1905, Section 5 of which prohibits the registration of a mark which "consists \* \* \* merely in words or devices which are descriptive of the goods with which they are used" or which is "merely a geographical name or term \* \* \*."

#### STATUTE INVOLVED

Section 5 of the Trade-Mark Act of February 20, 1905, 33 Stat. 725, as amended, 15 U. S. C. 85, provides, in part:

\* \* \* no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

\* \* \* \* \*

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, \* \* \*: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual,

or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: \* \* \*.

#### STATEMENT

On or about June 6, 1940, petitioner filed its application with the United States Patent Office to register the mark "Old English",<sup>1</sup> appearing in old English lettering, under the Trade-Mark Act of February 20, 1905, as a trade-mark for cheese (R. 2-3). The Examiner of Trade-Marks refused to register the mark "Old English" on the ground that the mark is "geographically descriptive of old English cheese," and thus "merely geographical" within the meaning of the proviso of Section 5 of the Act of February 20, 1905 (R. 49). This decision was affirmed on appeal by the First Assistant Commissioner of Patents (R. 50).

Petitioner thereupon brought suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes (35 U. S. C. 63), to compel the Commissioner of Patents to allow the registration of the mark "Old English" under the 1905 Act (R. 1-4). After trial (R. 6-36), the district court dismissed

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<sup>1</sup> Petitioner disclaimed the exclusive right to the use of the word "English" (R. 2, 37).



the complaint (R. 38), holding that "the meaning which the words 'Old English' would produce on a buyer would be that at least it represented cheese made in the Old English manner" (R. 37). On appeal, the United States Court of Appeals for the District of Columbia affirmed the dismissal of the complaint (R. 52-54).

#### ARGUMENT

1. Whether the mark "Old English" as a trademark for cheese is "fanciful" (Pet. 4, Br. 13-14, 18), and without "geographical or descriptive" significance (Br. 18) is a factual issue which has been decided adversely to petitioner's contentions. The district court found (R. 38):

4. The word "English" is geographical and the word "Old" is descriptive.

5. The meaning that the words "Old English" would produce on a purchaser of a package of cheese bearing those words, would be that, at least it indicated cheese made in the old English manner.<sup>2</sup>

The court below accepted and relied upon these findings of fact in reaching its decision (R. 52).

The finding of the Examiner of Trade-Marks (R. 49) and the Assistant Commissioner of

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<sup>2</sup> The Examiner of Trade-Marks likewise found: "Old cheese has quite a vogue, as does, presumably, English cheese. The mark may therefore be regarded as geographical or as geographically descriptive of old English cheese" (R. 49). The Assistant Commissioner of Patents, in his decision, adopted this finding of the Examiner (R. 50).

Patents (R. 50), the independent finding of the district court (R. 38), and the acceptance of the district court's finding by the court below (R. 52-53), conclude petitioner's contrary contention that the mark is "fanciful", *Goodyear Co. v. Ray-O-Vac Co.*, 321 U. S. 275, 278; *Abbot v. Coe*, 109 F. 2d 449, 451-452 (App. D. C.); *Williams Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367, and the evidence is sufficient to support these findings. The cheese which petitioner markets under the mark "Old English" is a cheddar type cheese (R. 32), and was sometimes marketed in packages labeled "Old English Pasteurized Process Cheddar Cheese" (R. 33). Cheddar cheese "is so named from the village of Cheddar in Somersetshire, England, where it was first made. It is comparatively an old cheese, though the genuine Cheddar process as it is now known is not old." *Varieties of Cheese: Descriptions and Analyses*, United States Department of Agriculture Bulletin No. 608, 1943, p. 10; see also R. 17.<sup>3</sup> Clearly there-

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<sup>3</sup> In support of its claim that the mark "Old English" is used in a fanciful sense, petitioner contended in the district court and now seems to contend (Pet. 7) that the cheese which it markets under that mark is neither "Old" nor "English" (R. 13, 14, 31). Such a contention does not, however, aid the petitioner, for old and aged cheeses are well known, as are "English" type cheeses (see *Varieties of Cheese: Descriptions and Analyses*, United States Department of Agriculture Bulletin No. 608, 1943, p. 18; see R. 9) and the mark is therefore descriptive albeit inaccurate. A misdescriptive mark confers no rights either at common law (*Worden v. California Fig*

fore, the words "Old English," as applied to a cheddar type cheese,<sup>4</sup> are not, as petitioner contends, "fanciful," but are, as the Examiner of Trade-Marks and the Assistant Commissioner of Patents found, "geographically descriptive of Old English cheese" (R. 49-50), and would, as the district court found, indicate to a prospective purchaser "cheese made in the old English manner" (R. 38).

2. Geographically descriptive marks were refused recognition as valid trade-marks at common law,<sup>5</sup> and under the 1905 Act both the Patent Office and the courts have consistently denied registration to them. *Ex Parte Boyle*, 125 Manuscript Decisions of the Commissioner of Patents 282, 8 T. M. Rep. 230 ("Old English" as applied to floor wax); *In Re Hopkins*, 29 App. D. C. 118 ("Oriental Cream" as applied to face lotion); *Johnson v. Brandau*, 32 App. D. C. 348 ("Asbestos" as applied to shoes); *Kentucky Distilleries & W. Co. v. Old Lexington Club Distilling Co.*, 31 App. D. C. 223 ("Old Lexington Club" as *Syrup Co.*, 187 U. S. 516, 536-537, 539-540) or under the 1905 Act (*In Re Bonide Chemical Co., Inc.*, 46 F. 2d 705 (C. C. P. A.); *In Re International Resistance Co.*, 69 F. 2d 566 (C. C. P. A.)).

<sup>4</sup> Other types of "English" cheese are not unknown. See description of "English Dairy" cheese in *Varieties of Cheese: Descriptions and Analyses*, *op. cit.*, *supra*, at p. 18; see also R. 32.

<sup>5</sup> See cases cited in Nims, *Unfair Competition and Trade-Marks* (3d Edition, 1929), pp. 526-528, 538-542.

applied to whiskey); *Dennehy & Co. v. Robertson Co.*, 32 App. D. C. 355 ("Mountain Dew" as applied to whiskey); *In re Deutz & Ortenberg, Inc.*, 54 App. D. C. 265 ("House of France" as applied to dresses); *Black Band Consolidated Coal Co. v. Glenn Coal Co.*, 57 App. D. C. 268 ("Black Band" as applied to coal); see also cases cited in Nims, *Unfair Competition and Trade-Marks* (3d Edition, 1929), pp. 630-636, and in Derenberg, *Trade-Mark Protection and Unfair Trading* (1936), p. 257, *et seq.*

The petitioner's reliance (Br. 14-16) on *Hamilton-Brown Shoe Company v. Wolf Bros. & Company*, 240 U. S. 251, and *Southeastern Brewing Company v. Blackwell*, 80 F. 2d 607 (C. C. A. 4), is misplaced. Neither involved the Act of 1905, and both are, for this and other reasons, readily distinguishable. In the *Hamilton-Brown* case, the mark "American Girl" was held to have no significance as applied to shoes, and was thus regarded as neither geographical nor descriptive. But in the light of the findings in this case, it cannot be assumed that "Old English" has no geographically descriptive significance as a mark for cheddar cheese. In the *Southeastern Brewing* case, the words "Old South" or "Old South Brew", as applied to beer, were held to constitute a valid common-law trade mark. But there, contrary to petitioner's assertion (Br. 15), the court was moved by considerations of the mark's secondary

significance. (See *infra*, pp. 9-11.) The court stated that descriptive marks, if "merely suggestive, and especially if they had acquired, by use, a secondary significance", would be recognized as valid common-law trade-marks, and that "the words 'Old South Brew' \* \* \* had acquired a secondary significance in the territory in which [appellant and its assignors] were operating" (p. 609).

3. Petitioner also contends that the court below failed to give "consideration to the fanciful meaning of the mark *in its entirety*," and that "In the case of 'Old English' the coupling together of the two separately unregistrable words has produced a new fanciful meaning" (Br. 16-18). Such a contention does not aid petitioner, for it is established that "a registrable mark cannot be made by combining two nonregistrable words". In *re Meyer Brothers Coffee & Spice Company*, 32 App. D. C. 277, 278; see also *Kentucky Distilleries & W. Co. v. Old Lexington Club Distilling Co.*, 31 App. D. C. 223. In *Beckwith v. Commissioner of Patents*, 252 U. S. 538, upon which petitioner relies (Br. 16), this Court held that the words "Moistair Heating System" standing alone could not be registered because they were "merely descriptive" (p. 544), and that they could be registered under the 1905 Act only as part of a composite mark comprising the head of an Indian Chief named "Doe-Wah-Jack" and the words "Round Oak". As the court below pointed out,

"No doubt if the phrase 'Old English' had been an integral part of some peculiar design or seal such an arbitrary arrangement could have been registered. But that is not the case here. The only peculiarity of this trade-mark is the fact that [petitioner] uses a familiar Gothic type." (R. 53.)

4. Petitioner argues "that the composite mark 'Old English' serves to distinguish petitioner's cheese from that of other manufacturers," that it "qualifies for registration under the general language of section 5 of the 1905 Act," and "is not disqualified by any of the provisos or exceptions in said section" (Br. 18). As a descriptive or geographical mark, however, the words "Old English" could serve "to distinguish Petitioner's cheese from that of other manufacturers" only through the acquisition of a secondary meaning, which in turn would result from long usage and a general recognition of the mark by the public as identifying petitioner's product. Derenberg, *op. cit.*, *supra*, at pp. 338 *et seq.*

But petitioner does not argue that its mark has acquired a secondary meaning, no doubt because the only "descriptive \* \* \* or merely \* \* \* geographical" marks presumed to have a secondary meaning under the 1905 Act are those registrable under the ten-year provision of Section 5—*i. e.*, those which were used exclusively and in good faith for ten years prior to the passage of

the 1905 Act. See *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 470; *Illinois Watch Case Co. v. Shulton*, 111 F. 2d 298, 299 (C. C. P. A.); *Manitou Springs Mineral Water Co. v. Schucler*, 239 Fed. 593, 602 (C. C. A. 8); *Elgin National Watch Co. v. Elgin Razor Company*, 25 F. Supp. 886, 887 (N. D. Ill.). Since petitioner did not seek registration of the words "Old English" under the ten-year provision, no secondary meaning or arbitrary or fanciful usage can except the mark from the proviso of Section 5 of the 1905 Act prohibiting the registration of "descriptive \* \* \* or merely \* \* \* geographical marks." *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324; *In re Canada Dry Ginger Ale*, 86 F. 2d 830 (C. C. P. A.); see also *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, where this Court recognized the established secondary meaning of the word "Elgin" as a trade-mark for watches, but refused it registration under the Trade-Mark Act of March 3, 1881, 21 Stat. 502 (the predecessor of the 1905 Trade-Mark Act) because it was a "geographical name" (p. 677).<sup>6</sup> In these circum-

<sup>6</sup> Pending legislation in the 79th Congress reveals a recognition of the current state of the law in this regard—*i. e.*, with the exception of marks falling within the ten-year provision of Section 5 of the 1905 Act, geographical or descriptive

stances, the Patent Office and the courts below properly refused registration to petitioner's mark.<sup>7</sup>

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marks are not registrable under that Act, even though such names or marks may have acquired secondary significance. Section 2 (f) of H. R. 1654, 79th Cong., 1st Sess., an Act "To provide for the registration and protection of trade-marks used in commerce \* \* \*," permits the registration of descriptive or geographically descriptive marks if, "as used by the applicant," they have "become distinctive of the applicant's goods in commerce." In such circumstances, the Commissioner of Patents "may accept as *prima facie* evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration." H. R. 1654 was passed by the House of Representatives on March 5, 1945, and on March 6, 1945, was referred by the Senate to its Committee on Patents.

<sup>7</sup> The ruling of the court below does not estop petitioner from seeking registration of its mark under Section 1 (b) of the Act of March 19, 1920 (41 Stat. 533, 15 U. S. C. 121 (b)), which permits the registration of marks not registrable under the proviso of Section 5 of the 1905 Act "which have been in bona fide use for not less than one year in interstate or foreign commerce." Indeed, the Commissioner of Patents noted in his decision that petitioner's "mark is registrable, if at all, under the Act of March 19, 1920" (R. 50). The provisions of the 1920 Act were recently examined by this Court in *Armstrong Co. v. Nu-Enamel Corp.*, 305 U. S. 315, where it was stated that the "obvious purpose of [Section 1 (b) of the 1920 Act] was to widen the eligibility of marks" not registrable under the proviso of Section 5 of the 1905 Act (p. 330).



## CONCLUSION

The decision below is correct and rests on the particular facts of this case. There is no conflict of decisions. The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

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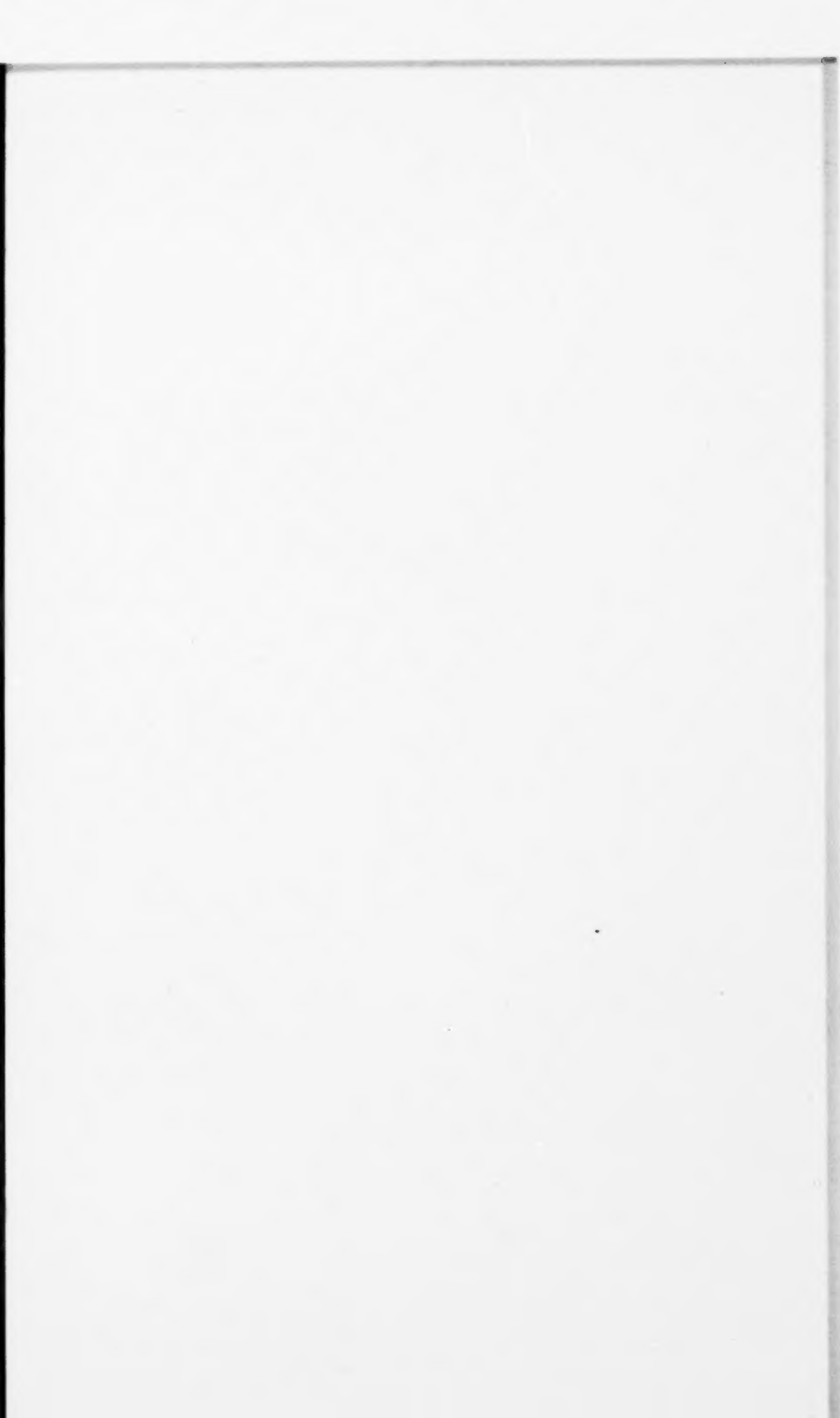
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APRIL 1945.





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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1944.

**No. 1084**

KRAFT CHEESE COMPANY,

*Petitioner,*

*vs.*

CONWAY P. COE, COMMISSIONER OF PATENTS,

*Respondent.*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

**PETITIONER'S REPLY TO RESPONDENT'S BRIEF.**

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April 30, 1945.



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COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

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**PETITIONER'S REPLY TO RESPONDENT'S BRIEF.**

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**Item 1,—The District Court's Findings.**

On page 4 of Respondent's Brief, paragraphs 4 and 5 of the District Court's findings are quoted, and Respondent says: "The Court below accepted and relied upon these findings of fact in reaching its decision. (R. 52.)"

Plaintiff-Petitioner challenged paragraph 5 (See R. 39) on the ground that there was no evidence to support the same, and this point was argued in the Court of Appeals. An examination of the Court of Appeals' decision (R. 52) shows that the sole ground relied upon for refusing relief is included in paragraph 4 of the findings, *i. e.*, that

"Old" is descriptive, and "English" is geographical. The Court of Appeals decision contains no reference to paragraph 5 of the District Court's findings.

### **Item 2,—Secondary Significance.**

Petitioner freely admits that, under the 1905 act, any mark which, as an entirety, has a descriptive or a geographical meaning, cannot be registered unless it was used prior to 1905 and thus qualifies under the ten-year proviso. Throughout this proceeding, Petitioner has never relied solely upon the fact that its mark has acquired a secondary significance by reason of its use since the year 1912. In this respect, the Court of Appeals and Respondent's counsel have misconstrued Petitioner's argument.

Petitioner's position is that the mark is registrable because it is inherently a fanciful mark in its entirety, and that, in its entirety, it is neither descriptive, nor is it geographical. As to the *Hamilton Brown Shoe Company v. Wolf Bros.* case, 240 U. S. 251, it is true that registration under the 1905 Act was not involved, but, in determining what recovery should be allowed, the Defendant argued that "American Girl" was not a good technical, common law trade-mark and that the damages should be limited under the unfair competition theory of palming off, based upon secondary significance. Thus, the question of whether the mark "American Girl" was a good technical mark was directly presented to the Supreme Court, which held that it was a legitimate trade-mark.

As pointed out in our main brief (p. 9), it was the intention of Congress to permit the registration of all technical or legitimate common law trade-marks. Therefore, the sole question here is whether the mark "Old English" is, or is not, a good, legitimate, common law trade-mark. If "American Girl" is inherently a good, legitimate trade-

mark, so should be "Old English." No question of secondary significance is involved.

In the "Old South" case, also referred to on page 7 of Respondent's Brief, it is true that, in the majority decision, secondary significance due to use in a specific territory is mentioned, but the use was very slight. It was neither extensive nor long continued, in fact so short (only eight months) that it is difficult to see how the case could have been controlled by it.

Regardless of the reasons for the "Old South" decision, the fact is that, since that decision, the Patent Office has registered the mark "Old South" under the 1905 Act. (R. 47, 48.)

### **Item 3,—English Dairy.**

At the foot of page 5 of his brief, Respondent refers to Agriculture Bulletin No. 608. This Bulletin is not in evidence. It was quite unnecessary for Respondent to go outside of the record. Petitioner's witness, Kraft (Rec. 32), testified fully and frankly about this so-called "English Dairy" cheese, a type which has been made in the United States in small quantities and is now practically extinct.

We cannot see how the use of the words "English Dairy," as applied to a type of cheese made in this country, can have any possible bearing upon Petitioner's right to register the mark "Old English" in its entirety. Petitioner is not seeking to register the word "English" separately from the composite mark. In fact, the exclusive use of the word "English" has been disclaimed, from the inception of this proceeding.



**Item 4,—The 1920 Act.**

At the foot of page 11, in the footnote, Respondent repeats the suggestion, originally made by the Patent Office, that the mark could be registered under the 1920 Act, which permits the registration of descriptive or geographical marks. But to do so would require the Petitioner to admit that its mark, as an entirety, is either geographical or descriptive. Such an admission might furnish an unscrupulous competitor with a made-to-order, plausible excuse for imposing upon the public by imitating a mark which he would not dare infringe upon, if it had been registered under the Act of 1905. Such a 1920 registration might brand Petitioner's mark with a stigma from which it might never recover.

We submit that the 1920 Act was not passed by Congress for the purpose of supplying the Commissioner of Patents with a convenient waste basket in which to dispose of troublesome cases, or to serve as an excuse for resolving all questions against an Applicant under the 1905 Act.

Respectfully submitted,

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